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Paper No. 23
BAC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

United States Olympic Committee
v.
Calcados Azaleia S.A.

Opposition No. 110,696
to application Serial No. 75/283,397
filed on April 29, 1997

James L. Bikoff of Silverberg, Goldman & Bikoff, LLP for
United States Olympic Committee.

Paul M. Denk, Esq. for Calcados Azaleia S.A.

Before Seeherman, Walters and Chapman, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

Calcados Azaleia S.A. (a Brazil corporation)
(hereinafter applicant) filed an application to register
the mark OLYMPIKUS on the Principal Register for
"footwear" in International Class 25. The application
was filed on April 29, 1997, based on applicant's
allegation of a bona fide intention to use the mark in
commerce.

The United States Olympic Committee (a Congressionally chartered non-profit corporation) (hereinafter opposer or USOC) has opposed registration of the mark, alleging that "Olympicus" is the Latin word for "Olympic"; that the letter "c" does not exist in the Greek alphabet and is represented as the letter "k"; and that registration of applicant's mark OLYMPIKUS, being the foreign equivalent of "OLYMPIC," would violate Sections 2(a) and 2(d) of the Trademark Act, 15 U.S.C. §§1052(a) and (d), and Section 380(c) of the Amateur Sports Act of 1978, 36 U.S.C. §380(c).¹ Opposer further alleges that it owns registrations for the following marks: (i) OLYMPIC for a variety of goods (not including any clothing or footwear items) and services and as a collective membership mark², (ii) OLYMPIAN for golf clubs³, (iii) OLYMPIAN for magazines⁴, (iv) OLYMPICAP for caps, hats and visors⁵, and (v) the mark shown below for "footwear, namely, shoes"⁶;

¹ The Amateur Sports Act of 1978 was amended by Congress in 1998 in a section now numbered 36 U.S.C. §220506.

² Registration No. 968,566, issued September 18, 1973, Section 8 affidavit accepted, renewed.

³ Registration No. 1,630,966, issued January 8, 1991, Section 8 affidavit accepted, renewed.

⁴ Registration No. 1,734,781, issued November 24, 1992, Section 8 affidavit accepted, Section 15 affidavit acknowledged.

⁵ Registration No. 1,986,043, issued July 9, 1996.

⁶ Registration No. 1,458,432, issued September 22, 1987, Section 8 affidavit accepted. The term "USA" is disclaimed.



that since opposer was organized in 1921, it has used and has licensed others to use its registered and other Olympic-related marks on a wide variety of goods and services,

including clothing and footwear; that through long and continuous use opposer's trademarks have become extremely well known to consumers; that applicant's mark, if used in connection with its goods, so resembles opposer's previously used and registered marks as to be likely to cause confusion, mistake, or deception; that opposer is charged by Congress with the responsibility for organizing and sponsoring this country's participation in the modern Olympic Games, inspired by the ancient Greek games; that Congress gave opposer exclusive rights to certain marks, including but not limited to the word OLYMPIC, as well as prohibiting any person from using any simulation of the word OLYMPIC which tends to cause confusion, mistake or deception, or to falsely suggest a connection with opposer; that registration of applicant's mark will interfere and conflict with opposer's authority to prohibit the use of "simulations" of the marks OLYMPIC and OLYMPIAD under 36 U.S.C. §380; and that opposer's marks have become so famous and so uniquely and unmistakably associated with opposer that registration to applicant would cause the public to falsely presume a connection between applicant and opposer. Finally, opposer alleges that all three of the statutory bases for prohibiting registration to applicant are heightened

because the Federation International de Volleyball has officially approved applicant's shoes and uniforms bearing the OLYMPIKUS mark for official volleyball competitions, and volleyball is an Olympic sport.

Applicant denied the salient allegations of the notice of opposition, leaving opposer to its proof at trial.

Opposer made nothing of record during its trial period in this case. At the close of opposer's testimony period, applicant could have filed a motion to dismiss pursuant to Trademark Rule 2.132(a), but did not do so. Accordingly, opposer filed its brief on the case, and attached several exhibits to the brief (Exhibits A-I). Applicant objected thereto, arguing that none of the exhibits had been submitted under a notice of reliance or as part of testimony during opposer's trial period; that certain exhibits were not produced to applicant during discovery; and that certain exhibits could not properly be submitted by way of notice of reliance under the Trademark Rules of Practice. (Applicant's Brief, pp. 13-15.)

However, thereafter, the parties stipulated certain exhibits to be of record, as evidenced by opposer's reply brief. Specifically, in its reply brief (p. 1), opposer

Opposition No. 110696

states that "the parties arrived at agreement regarding Opposer's exhibits." On page 2 of the reply brief, opposer explains that under the agreement between counsel, applicant objects to Exhibit B (list of Olympic sponsors and licensees), part of Exhibit C (pages 4-13, opposer's royalty payment reports regarding JCPenney), and Exhibit E (four pages from applicant's website); and that "[i]t is stipulated that there is no dispute or objection to the admissibility of the rest of Opposer's exhibits." Opposer attached to its reply brief photocopies of two letters from opposer's attorney to applicant's attorney concerning applicant's objections and the subsequent agreement relating thereto.

Opposer's reply brief indicates proof of service of a copy thereof on applicant's attorney, and no further papers have been received in this case. Accordingly, we consider the following evidence to have been stipulated into the record:

- (1) Exhibit A--photocopies of opposer's five pleaded registrations;
- (2) Exhibit C--photocopies of three pages from a JCPenney catalog;
- (3) Exhibit D--photocopies of pages from Latin dictionaries;
- (4) Exhibit F--photocopies of pages from opposer's "1997-1998 factbook";

Opposition No. 110696

- (5) Exhibit G--a photocopy of applicant's previous, now-abandoned application (Serial No. 74/623,876) for the mark OLYMPIKUS for shoes;
- (6) Exhibit H--applicant's responses to opposer's requests for admission; and
- (7) Exhibit I--applicant's responses to opposer's first set of interrogatories.

Thus, the record consists of the pleadings; the file of the opposed application; and the above-identified stipulated evidence.

At this juncture, we will address the photocopies of registrations submitted by opposer as Exhibit A to its brief, which have been stipulated into the record. Normally, pleaded registrations are properly made of record through the plaintiff's submission of current status and title copies prepared by the USPTO, or through testimony regarding current status and title. See Trademark Rule 2.122(d). In this case, opposer has submitted only photocopies of the registrations, not status and title copies. However, applicant has stipulated them into the record, and in applicant's brief it has specifically discussed opposer's registrations. For example, applicant makes the following statements:

- (i) "Applicant's OLYMPIKUS trademark upon comparison with the registration(s) of Petitioner [sic] is not likely to cause confusion," p. 3;
- (ii) "[applicant's] mark, upon

Opposition No. 110696

the word OLYMPIKUS standing alone, as used on footwear, is not likely to cause any confusion with the registration [Registration No. 1,458,432], or any registration of the USOC," p. 4; (iii) "when you compare this registration [Registration No. 1,458,432] with Applicant's mark OLYMPIKUS, ... the mark as a whole is not likely to be confused by Applicant's usage of its OLYMPIKUS mark," p. 10; and (iv) "... when compared to the trademark registration No. 1,458,432, registered by the USOC, for use upon footwear," p. 12. Accordingly, we find that applicant has stipulated to the validity of the five registrations pleaded by opposer.

The only evidence of record regarding opposer and its marks are Exhibits A, photocopies of opposer's five pleaded registrations; C (pages 1-3), photocopies of three pages from the 1998 JCPenney catalog showing USA OLYMPIC BRAND shoes for sale; and F, photocopies of three pages from opposer's "1997-1998 factbook" discussing opposer's licensing program. In addition, the Amateur Sports Act of 1978 grants opposer rights in certain marks. From this record it is clear that opposer has statutory rights in the mark OLYMPIC; that opposer's licensing program generates millions of dollars in retail

sales; and that opposer licenses the mark OLYMPIC for use on shoes to JCPenney.

In addition to the stipulated exhibits, opposer is seeking, in its brief, to rely, in part, on prior decisions by courts to establish facts in this opposition proceeding. However, the factual findings in those court cases were based on the evidence presented therein, and do not establish factual matters before the Board in this opposition. Even the interpretation of the Amateur Sports Act in the cited court cases relates to the application of that law to the specific facts proven in the cases before those courts.

There is little information of record regarding applicant except the application file; applicant's previous now-abandoned application to register the mark OLYMPIKUS for shoes (application Serial No. 74/623,876); and applicant's responses to opposer's requests for admission and its answers to opposer's first set of interrogatories. From this evidence, we know that applicant is a corporation of Brazil, located in Brazil; that "its principal business is the sale of footwear in the United States" (answer to opposer's interrogatory No. 1); that applicant has not used the mark in connection with any goods or services in the United States (e.g.,

response to opposer's request for admission No. 3, and answer to opposer's interrogatory No. 60); that applicant contends OLYMPIKUS is a coined term, and its selection "stemmed from observations made by Nestor Herculano de Paula [the person who conceived of and authorized applicant's use of the term OLYMPIKUS] of "olympic" names and derivations thereof while he was in Greece in 1972" (answers to opposer's interrogatory Nos. 14 and 31); and that "applicant first learned of select USOC marks from its earlier search, from its earlier application, and from prior correspondence" (answer to opposer's interrogatory No. 42).

We turn first to the issue of likelihood of confusion. In determining this issue we follow the guidance of the Court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976); and *In re Azteca Restaurant Enterprises Inc.*, 50 USPQ2d 1209 (TTAB 1999). See also, *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 57 USPQ2d 1557, 1559 (Fed. Cir. 2001).

Opposition No. 110696

Because opposer's pleaded registrations have been made of record by stipulation and their validity acknowledged by applicant, the issue of priority does not arise. See *King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974); and *Carl Karcher Enterprises Inc. v. Stars Restaurants Corp.*, 35 USPQ2d 1125 (TTAB 1995).

Considering then the similarities or dissimilarities of the goods, applicant's goods are identified as "footwear," and opposer's goods in Registration No. 1,458,432 are identified as "footwear, namely, shoes." Clearly, applicant's identification of goods encompasses "shoes," and we must assume that if applicant commenced use of this mark for the identified goods in the United States, the goods would be sold through all normal channels of trade to all the usual purchasers for those goods. See *Octocom Systems Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); and *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991).

Accordingly, we find that the parties' goods are legally identical, and that the goods would be sold in the same channels of trade to the same classes of purchasers.

Regarding the marks, we begin with the premise that "when marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." See *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). In this case, there are obvious differences between the marks, including that applicant's mark is the word OLYMPIKUS alone, whereas opposer's mark is a composite mark, as shown below,



consisting of the word OLYMPICS, the letters "USA," and a design of the five interlocking rings [the symbol of the International Olympic Committee--see 36 U.S.C. §220506(a)(2)]. Although the word OLYMPICS is in smaller type than the letters "USA," it appears twice and is a strong, noticeable element.

While the differences in the marks described by applicant are essentially accurate, we nonetheless find that these marks, OLYMPIKUS and OLYMPICS USA and design, have sufficient similarities that consumers are likely to view the marks as variations of each other, with both

indicating a common source for the goods. Thus, purchasers, upon seeing applicant's mark on footwear, would assume that applicant's goods come from the same source as opposer's goods, or are sponsored by or associated with opposer. See *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Importantly, footwear or shoes are everyday consumer goods sold to the ordinary purchaser; and such goods can be sold at low prices. For example, in the JCPenney catalog, the price listed for the shoes offered under the OLYMPIC mark is \$18.99.

Accordingly, because the goods, the trade channels, and the classes of consumers are identical; and because the parties' marks are similar; we find that there is a likelihood that the purchasing public would be confused if applicant uses OLYMPIKUS as a mark for footwear.

Applicant, as the newcomer, had the obligation to select a mark which would avoid confusion. Thus, to the extent there is any doubt on this issue, it must be resolved in opposer's favor. See *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993).

Having found that there exists a likelihood of confusion resulting from the contemporaneous use of applicant's mark OLYMPIKUS on footwear and opposer's mark OLYMPICS USA and design on shoes, we elect not to consider the remainder of opposer's Section 2(d) claim as to its other registered marks, specifically, OLYMPIC for a wide variety of goods and services and collective membership, OLYMPIAN for golf clubs, OLYMPIAN for magazines, and OLYMPICAP for caps, hats and visors. See *American Paging Inc. v. American Mobilphone Inc.*, 13 USPQ2d 2036, 2039 (TTAB 1989), *aff'd* 17 USPQ2d 1726 (Fed. Cir. 1990)(unpublished); and *Goldring, Inc. v. Towncliffe, Inc.*, 234 F.2d 265, 110 USPQ 284, 285 (CCPA 1956).

As for the remaining grounds, we note opposer's notice of opposition included the wording "[r]egistration of Applicant's mark will dilute the distinctiveness of the [opposer's] trademarks...." (paragraph 10). However, this allegation was made in the context of opposer's likelihood of confusion claim. Moreover, opposer specifically enumerated only three grounds for the opposition (Sections 2(a) and 2(d) of the **Trademark Act**, and Section 380 of the Amateur Sports Act). Accordingly, although opposer did argue the issue of dilution as a

ground for opposition in its brief, we do not consider the pleadings to have adequately set forth such a claim, or the evidence submitted "at trial" to have put applicant on notice of a dilution claim, such that we could deem the pleadings to have been amended.⁷ See Sections 13(a) and 43(c) of the **Trademark Act**; *Boral Ltd. v. FMC Corp.*, 59 USPQ2d 1701 (TTAB 2000); and *Polaris Industries Inc. v. DC Comics*, 59 USPQ2d 1798 (TTAB 2000). Moreover, the very sparse record before the Board clearly does not establish dilution. Thus, we find that the ground of dilution was neither pleaded nor proven in this case.

Turning to opposer's claim under Section 2(a) of the **Trademark Act** that applicant's mark falsely suggests a connection with opposer, we will not go into an extended discussion of this claim, but we merely note that opposer has not met the burden of proof necessary on the elements of such a ground. See *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); *In re Sloppy Joe's*

⁷ At the time the notice of opposition was filed, the Board had no authority under the **Trademark Act** to determine the issue of dilution and, in fact, as noted previously, the notice of opposition makes no reference to a basis for opposition under Section 43(c) of the **Trademark Act**.

International Inc., 43 USPQ2d 1350 (TTAB 1997); and Buffett v. Chi-Chi's, Inc., 226 USPQ 428 (TTAB 1985).

Finally, turning to opposer's pleaded claim that applicant's mark violates Section 380 of the Amateur Sports Act of 1978, opposer refers in its brief not to its pleaded ground, but to the 1998 Olympic and Amateur Sports Act amendment to the Amateur Sports Act of 1978. Federal cases should be decided in accordance with the law existing at the time of decision (with certain exceptions, which are not relevant herein). See U.S. Olympic Committee v. Toy Truck Lines Inc., 237 F.3d 1331, 57 USPQ2d 1380 (Fed. Cir. 2001). Thus, we consider this particular pleaded ground in the context of the now-renumbered Section 220506 of the Amateur Sports Act as amended in 1998.

Section 220506 states the following ("the corporation" referred to therein is the opposer in this case):

36 U.S.C. §220506(a). Exclusive right of corporation.—Except as provided in subsection (d) of this section, the corporation has the exclusive right to use— ...

(4) the words "Olympic",
"Olympiad", "Citius
Altius Fortius",
"Paralympic",
"Paralympiad", "Pan-
American", "America

Espirito Sport
Fraternite", or any
combination of those
words.

It is clear from the statute that opposer has been granted rights in gross in certain specific words.⁸ The term OLYMPIKUS is not one of the listed words. We cannot agree with opposer's argument that OLYMPIKUS is a misspelling of the word OLYMPICUS, and because "Olympicus" is a Latin word that can be translated to "Olympic," that therefore, OLYMPIKUS is the equivalent of OLYMPIC. We deny opposer's claim under the 1998 Olympic and Amateur Sports Act amendment to the Amateur Sports Act of 1978.

Decision: The opposition is sustained based only upon Section 2(d) of the **Trademark Act**, and registration to applicant is refused.

⁸ Opposer has also been granted rights in gross in certain designs which are set forth in 36 U.S.C. §220506(a)(2) and (3).